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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,914

01/20/2005

Keyvan Mazda

1107-050118

7041

28289

7590

06/16/2006

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EXAMINER

CUMBERLEDGE, JERRY L

ART UNIT

PAPER NUMBER

3733

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/521,914	Applicant(s) MAZDA ET AL.	
	Examiner Jerry Cumberledge	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-21 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08/17/2005</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The disclosure is objected to because of the following informalities:

On page 1, line 30 the word "connects" should be changed to the word -connect-.

One page 8, lines 35-36 the reference numbers "S1" and "S2" should be changed to -51—and -52--, respectively.

Appropriate correction is required.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "58" in Fig. 2 has been used to designate two separate parts of the device. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each

drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "the section". There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the middle parts". There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "the other". There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the pivot". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 14, 15, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiz (U.S. Pat. 6,179,838) in view of Burgess et al. (WO 0209604 A1).

Fiz discloses a vertebral fixing system (Fig. 6 below) that is capable of mounting on a vertebra of the spine to connect it to a rod. The pedicle screw 8 (Fig. 6 below) is capable of mounting the system onto the spine. The system is capable of being placed on the spine in such a way that it would be in the vicinity of a posterior wall of a vertebra. The system comprises a connecting part (Fig. 6 below) capable of facing a rib and/or transverse process and capable of being connected to a rod. Fiz further discloses adjustable locking means (Fig. 6 below) fastened to the connecting part. The connecting part has a passage (as seen in cross section, Fig. 8 below) facing the rod. The adjustable locking means are capable of fixing the rod in place. The connecting part comprises two longitudinal members (Fig. 6 below), whose first ends are connected together and the members may pivot relative to each other. The middle parts (Figs. 6 and 9) of their two facing faces are capable of bearing on respective opposite sides of the rod. The adjustable locking means are capable of driving the second ends of the longitudinal members forcibly towards each other and to fix them in position relative to each other so that the two members form a clamp and grip the rod. This also allows the connecting part to be fixed in position relative to the rod. Fiz further discloses the second ends of the two longitudinal members having a bore in one and a thread in the other, so that a screw may be passed through the bore and screwed into the thread to

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form the adjustable locking means. The second ends of the longitudinal members have facing each other, a bore in one (Fig. 9 below) and a thread in another. Considering the nut 82 (Fig. 6 below) as part of the longitudinal member, the longitudinal member then has a threaded portion. A screw can then be passed through the bore into the thread and form the adjustable locking means. At least one of the middle parts of the two facing faces has a first portion (Fig. 8) through which the passage passes and a second portion capable of bearing against the rod (Fig. 8). The passage extends between two orifices in the connecting part (Fig. 9 below). The passage is extended between the two orifices, even though it does not span the entire distance between them. The passage has a section that decreases from one orifice to the other (Fig. 8 below), which enables the passage to exert a progressing pressure on the ligature and press it against the rod.

Fiz does not disclose a ligature with a first end attached to the connecting part and a second free end.

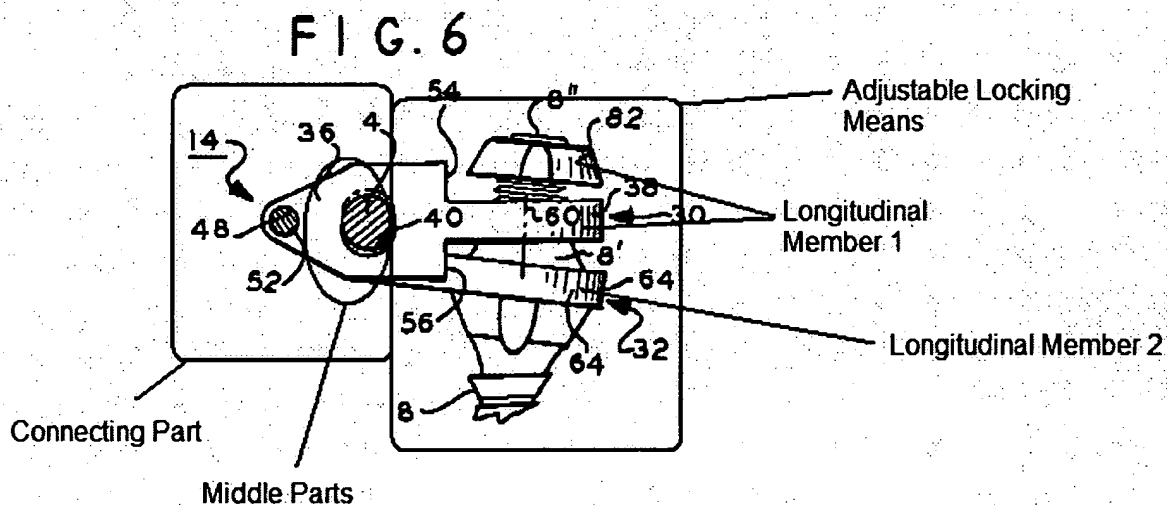
Burgess et al. (WO 02/09604 A1) disclose a ligature (Fig. 6, far bottom) with a first end attached to the connecting part and a free second end, the ligature being used for attaching the vertebral fixing system to the spine (page 2, paragraph 2, lines 1-3).

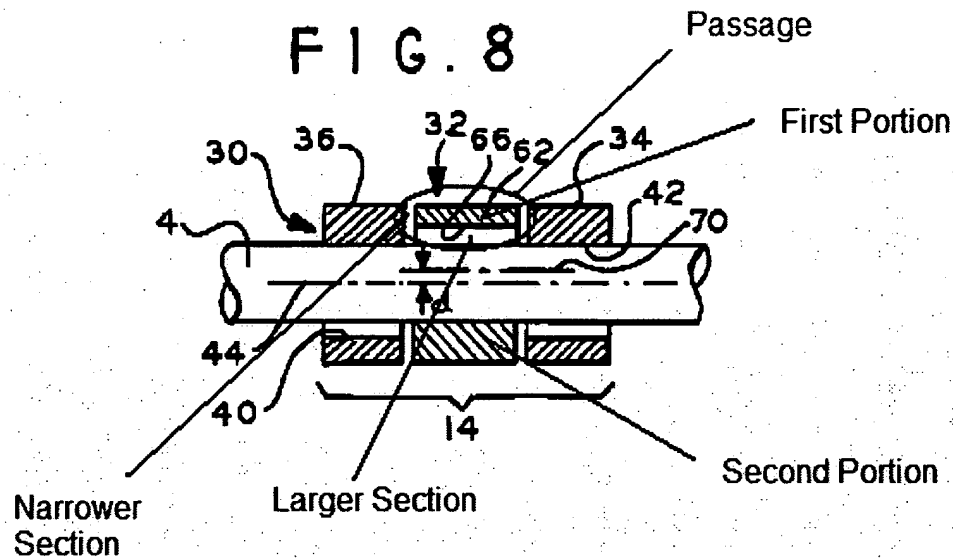
It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have constructed the vertebral fixing system of Fiz with the ligature attached to the connecting device of Burgess, in order to use the ligament to attach the vertebral fixing device to the spine.

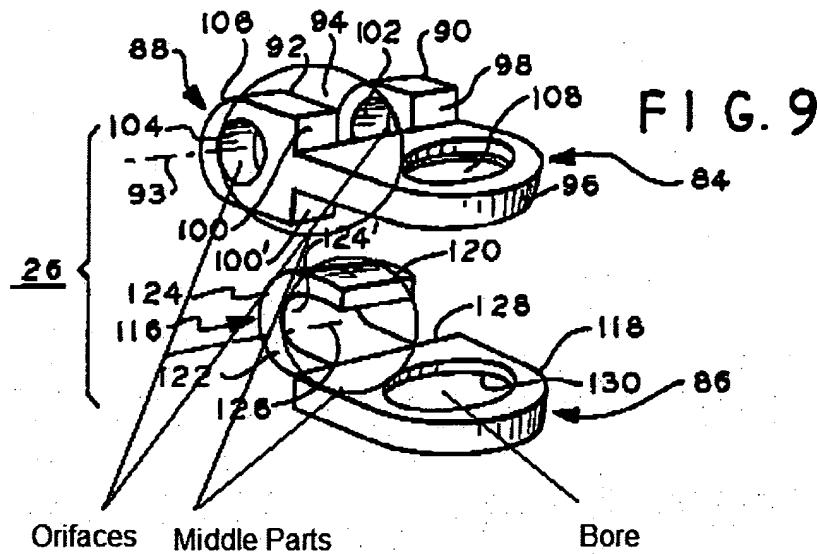
With regard to the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Fiz or

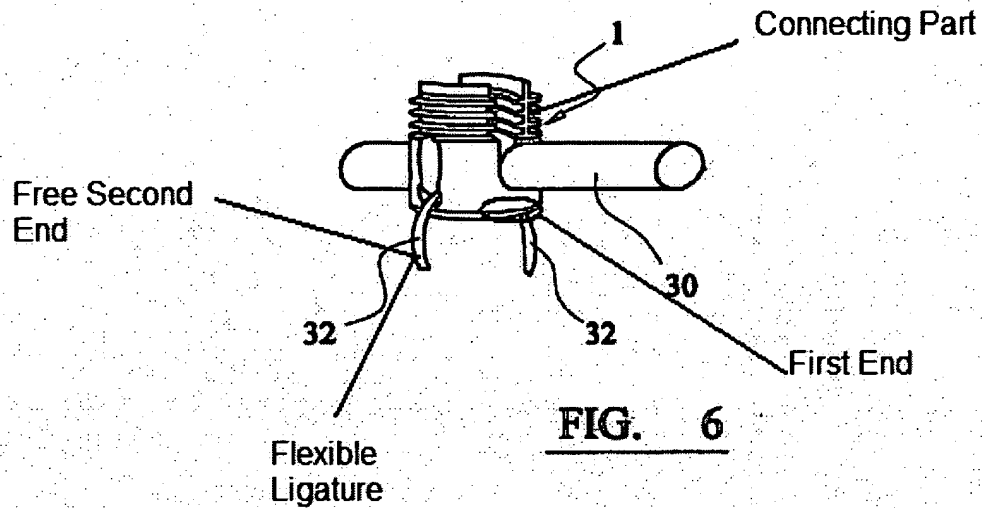
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Burgess et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).









Claims 13 and 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

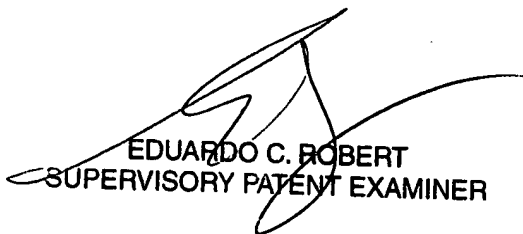
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892. The foreign reference Burgess et al. (WO 0209604 A1), which was supplied by the applicant, was relied upon in this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Cumberledge whose telephone number is (571) 272-2289. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JLC



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER